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OFFICE OF PETITIONS

In re Patent No. 6,803,593	:	LETTER REGARDING
Ohishi et al.	:	PATENT TERM ADJUSTMENT
Issue Date: October 12, 2004	:	and
Application No. 09/558,562	:	NOTICE OF INTENT TO ISSUE
Filed: April 26, 2000	:	CERTIFICATE OF CORRECTION
Attorney Docket No. 463P065	:	
	:	

This is in response to the "REQUEST FOR REDUCTION OF PATENT TERM ADJUSTMENT," filed October 20, 2004, pursuant to patentees' duty of candor and good faith to the Office. Patentees state that the patent term adjustment indicated on the Notice of Issuance (and in the patent) should be 0 days instead of 91 days.

The request for reconsideration of the patent term adjustment is **GRANTED**.

The patent term adjustment indicated in the patent is to be corrected by issuance of a certificate of correction showing a revised Patent Term Adjustment of **zero (0) days**.

Patentees are given **TWO (2) MONTHS** to respond to this decision. No extensions of time will be granted under § 1.136.

The instant application became eligible for patent term adjustment under the provisions of 35 U.S.C. 154(b) by virtue of the filing of a continued prosecution application on August 27, 2002. On October 12, 2004, the instant application matured into U.S. Patent No. 6,803,593, with a revised Patent Term Adjustment of 91 days printed thereon. Patentees disclose that this period of adjustment should have been reduced pursuant to 37 CFR 1.704(c)(10) for applicant's filing of a certified copy of the Japanese patent on November 10, 2003, after the mailing of the notice of allowance on October 30, 2003.

Patentees are correct. An additional period of reduction pursuant to § 1.704(c)(10) should have been entered in this application for the filing of a certified copy of a priority document after the mailing of the notice of allowance. 37 CFR

§ 1.704(c)(10) provides that circumstances that constitute a failure to engage in reasonable efforts to conclude prosecution include:

Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

(ii) Four months;

The Office's notice entitled *Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance*, 1247 OG 111 (June 26, 2001), specifically provides that:

the submission of other papers after a "Notice of Allowance" is mailed that do cause substantial interference and delay in the patent issue process are considered a "failure to engage in reasonable efforts" to conclude processing or examination of an application pursuant to 37 CFR 1.704(c)(10). The following are examples of such papers:

(1) a request for a refund, (2) a status letter, (3) amendments under 37 CFR 1.312, (4) late priority claims, (5) a certified copy of a priority document, (6) drawings, (7) letters related to biological deposits, and (8) oaths or declarations.

A review of the record confirms that a certified copy of a priority document was filed on November 12, 2003 (not November 10, 2003), after the mailing of the notice of allowance on October 30, 2003. On September 14, 2004, the Office responded with the mailing of an acknowledgment of priority papers. Thus, a period of reduction of the lesser period of four months should have been entered in this application (the number of days beginning on the date the paper was filed, November 12, 2003, and ending on the mailing date of the Office's response, September 14, 2004, is greater than four months).

The record reveals the period of reduction for applicant delay should be further increased. The reduction of 39 days for applicant delay in filing a response to the final Office action mailed March 31, 2003 is incorrect. As the amendment filed August 8, 2003 was not in compliance with § 1.113(c)¹, the period for reply to the final rejection mailed March 31, 2003, continued to run. The proper reply, a Request for Continued Examination (RCE)², was not received in the Office until September 22, 2003.

¹ See Advisory Action mailed August 26, 2003.

² Petitioner is reminded that: Subject to the provisions of 35 U.S.C. 154(b) and this subpart, the term of an original patent shall be adjusted if the issuance of the patent was delayed due to the failure of the Office to

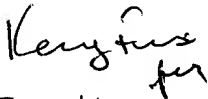
Pursuant to § 1.704(b), the patent term adjustment should have been reduced by 84 days for applicant delay from July 1, 2003 to September 22, 2003 in filing a proper reply to the final rejection.

In view thereof, the patent should have issued with a revised patent term adjustment of zero (0) days (150- 224).

As this letter was submitted as an advisement to the Office of an error in Patentees' favor, the Office will not assess the \$200.00 application fee under 37 CFR 1.705(b). The Office thanks patentees for their good faith and candor in bringing this to the attention of the Office.

The application file is being forwarded to the Certificates of Correction Branch for issuance of a certificate of correction in order to rectify this error. The Office will issue a certificate of correction indicating that the term of the above-identified patent is extended or adjusted by ZERO (0) days.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.



Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy

Enclosure: Copy of DRAFT Certificate of Correction

issue a patent within three years after the date on which the application was filed under 35 U.S.C. 111(a) or the national stage commenced under 35 U.S.C. 371(b) or (f) in an international application, but not including: (1) Any time consumed by continued examination of the application under 35 U.S.C. 132(b).